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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,106	12/27/2000	Cary Lee Bates	ROC920000234US1	6268
46797 7590 01/15/2008 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			EXAMINER VU, NGOC K	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 01/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/749,106

Applicant(s)

BATES ET AL.

Examiner

Ngoc K. Vu

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 5 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

3. The allowable subject matter of claim 5 has been withdrawn in view of the Bonomi and Palakoff references.

Claim Objections

4. Claims 5 and 15 are objected to because of the following informalities: the terms "wherein the threshold number..." in last two lines of claim 5 seem referring to "threshold number of subscribers belonging to the subscriber group" that is previously defined in line 10. Examiner respectfully suggests applicant to change terms "wherein the threshold number" to "threshold number of subscribers belonging to the subscriber group". Similarly, the terms "the threshold number..." in the last two lines of claim 15 seem referring to "threshold number of subscribers purchasing the same program belong to a common subscriber group" that is previously defined in lines 7-8. Examiner respectfully suggests applicant to change terms "wherein the threshold number" to "threshold number of subscribers purchasing the same program belong to the common subscriber group."

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitations "a first price for each purchase order if more than a threshold number of subscribers purchasing the same program...", "a second price...if less than the threshold number of subscribers purchasing the same program..." in connection with limitation "wherein the threshold number is all subscribers of the subscriber group" are not described in the specification. That is, the specification does not support the features of determining a first price for each purchase order if more than all subscribers of the subscriber group purchasing the same program, and determining a second price for each purchase order if less than all subscribers of the subscriber group purchasing the same program.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bonomi et al. (US 6,769,127 B1) in view of Pallakoff (US 6,269,343 B1).

Regarding claim 5, Bonomi teaches a method for determining a price of a program transmitted by a programming provider to subscribers, comprising: receiving (by 722 – figure 7A), via a network connection, a purchase order for a program from a subscriber (see col. 23, lines 40-45; figure 1B and 7A) belonging to a subscriber group defined by two or more subscribers (see customer list – figure 12A), wherein each subscriber belonging to the subscriber group maintains an independent account with the programming provider (see account information for Li Liu as shown in figure 12A) whereby the subscriber pays the programming provider in order to receive paid for programming (see figure 12A; col. 23, lines 36- 40 and 47-50; col. 2, lines 37-42; col. 21, line 67 to col. 22, line 1; col. 19, lines 14-18; col. 35, lines 1-22), and wherein each subscriber belonging to the subscriber group may elect to purchase or not purchase the program (the subscribers have the power to purchase or not purchase the program - see col. 9, lines 5-26 and figure 15F).

Bonomi teaches determining a price for purchase order (e.g., \$6.95 for each purchase order of movie “America Beauty” – see figure 15F). Bonomi does not explicitly teach determining a first price (special/discount price) for the purchase order if the program has been purchased by a threshold number of subscribers belonging to the subscriber group; and determining a second price (regular price), higher than the first price, if the program has not been purchased by the threshold number of subscribers belonging to the subscriber group, wherein the threshold number is all the subscribers of the subscriber group. However, Pallakoff discloses determining a price based upon a threshold number of purchasers and/or number of purchasers of buying group. For instance, Pallakoff’s system sends a message “We just need 5 more people to join the Buying Team in order to get the soccer ball for only \$10 each. Tell your

friends!" to suggest the current purchasers to tell their friends about the offer in order to get more buyers to join the buying group (see col. 10, lines 43-56). In other words, Pallakoff teaches determining a special/discount price P1 ("first price") based upon an actual number of purchasers of the buying group plus five (since need five more purchasers to join the buying group); and determining a regular price P2 ("second price"), higher than the special/discount price ($P2 > P1$ since P1 is a discount price), based upon an actual number of purchasers of the buying group plus n, where n is a number of buyers invited to join to the buying group and $0 \leq n \leq 4$. Therefore, the number of all current purchasers of the buying group plus five corresponds to "the threshold number of subscribers belonging to the subscriber group", and number of all current purchasers in the buying group corresponds to "the threshold number is all the subscriber of the subscriber group". It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bonomi by determining a price based upon a threshold number of purchasers and/or number of purchasers of buying group and enticing people to join in the buying group for offering a discount price as taught by Pallokoff in order to provide an effective way for conducting a marketing transaction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ngoc Vu/
NGOC K. VU
PRIMARY EXAMINER
Art Unit 2623

January 11, 2008